

**REMARKS****I. Status of the Claims**

The Final Office Action, page 1 (Office Action Summary), states that “claim(s) 1, 5-7 and 10-24 are is/are withdrawn from consideration.” Applicants note that Claims 21-24 were canceled on the transmittal filed February 14, 2001. Applicants assume that the Examiner inadvertently listed Claims 21-24 as being withdrawn claims.

The Final Office Action, on page 3, states that “[t]he written description rejection of claims 2-4 and 8-9 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Applicants note that Claim 9 was canceled in the Response filed March 13, 2003. Applicants assume that the Examiner inadvertently listed Claim 9 as being rejected on the basis of written description.

Applicants request clarification from the Examiner on the status of Claims 21-24 and Claim 9.

**II. Comments on the Restriction Requirement**

Applicants note that Claims 10-11 (Group V), Claim 12 (Group VI), Claim 16 (Group X), and Claim 17 (Group XI) are “method of use” claims drawn to methods of using the polynucleotides of Group II. Therefore, upon allowance of the polynucleotide claims of Group II, it is believed that Claims 10-11, 12, 16, and 17 should be rejoined and considered, in accordance with the Commissioner’s Notice in the Official Gazette of March 26, 1996, entitled “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b) which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products..

**III. Rejection of Claims 2-4 and 8 Under 35 U.S.C. § 112, first paragraph, written description**

The polynucleotides of Claims 2-4 and 8 have adequate written description as also explained in the Response filed March 13, 2003 (those comments being incorporated herein).

**IV. Rejection of Claim 8 Under the Judicially Created Doctrine of Obviousness-type Double Patenting**

The Examiner rejected Claim 8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 3-4 of U.S. Patent No. 5,817,497 (Office Action, pages 8-9). Applicants request that the requirement for submission of a Terminal Disclaimer be held in abeyance until such time as there is an indication of allowable subject matter.

Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

**CONCLUSION**

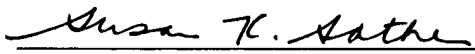
In light of the above remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,  
INCYTE CORPORATION

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